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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/867,920 | 05/29/2001 | Mathew Thankachan | SMQ-052 (P5699) | 7547 |
| 959 | 7590 | 09/08/2004 | EXAMINER | |
| LAHIVE & COCKFIELD, LLP. 28 STATE STREET BOSTON, MA 02109 | | | BAYARD, DJENANE M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2141 | |

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/867,920 | Applicant(s) THANKACHAN, MATHEW | |
| | Examiner Djenane M Bayard | Art Unit 2141 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 29 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of U.S. Patent No. 6,643,694 to Chernin.

a. As per claim 1, Special Edition Using Microsoft Outlook 2000 teaches an electronic device, said electronic device executing an email application, a method comprising the steps of: providing a plurality of storage locations for storing email messages, said email messages including a header and a body, said storage locations accessible by said email application, said email application designating one of said storage locations as an active storage location (See page 3 and figure 18.7); providing a search feature for use with said email application, said search feature including a user-input parameter, said search feature using said parameter to retrieve data from said email messages (See page 17 and 18 and figure 18.16); searching said designated active storage location with said search feature (See page 3 and figure 18.7); However, Special Edition Using Microsoft Outlook 2000 fails to teach retrieving data indicated

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by said parameter from selected email messages in said active storage location; and creating a new document containing data retrieved from said messages.

Chernin teaches retrieving data indicated by said parameter from selected email messages in said active storage location; and creating a new document containing data retrieved from said messages (See col. 34)

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate retrieving data indicated by said parameter from selected email messages in said active storage location; and creating a new document containing data retrieved from said messages as taught by Chernin in the invention of Microsoft Outlook in order to display the results of the e-mail search (See col. 34, lines 64-67)

b. As per claim 3, Special Edition Using Microsoft Outlook 2000 teaches wherein said search feature searches all of said plurality of storage locations for storing email messages (See page 3 and figure 18.7).

c. As per claim 4, Special Edition Using Microsoft Outlook 2000 teaches searching the header of said email messages for data referenced by said parameter; searching the body of said email messages for data referenced by said parameter; and searching any email attachments for data referenced by said parameter (See page 4).

d. As per claim 5, Special Edition Using Microsoft Outlook 2000 in view of Chernin teaches the claimed invention as described above. However, Special Edition Using Microsoft

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Outlook fails to teach wherein said new document is in Hypertext Markup Language (HTML) format.

Chernin teaches wherein the document is in Hypertext Markup Language (HTML) (See col. 34).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the document is in Hypertext Markup Language (HTML) as taught by Chernin in the claimed invention of Special Edition Using Microsoft Outlook 2000 in order to display the results of the e-mail search (See col. 34, lines 64-67),

e. As per claim 6, Special Edition Using Microsoft Outlook 2000 teaches wherein said search feature is integrated with said email application (See page 1).

f. As per claim 7, Special Edition Using Microsoft Outlook 2000 teaches wherein said search feature is a stand-alone application (See page2).

g. As per claim 8, Special Edition Using Microsoft Outlook 2000 teaches wherein the email data in said new document is sorted by date of creation of the email message from which the data was retrieved (See page 11).

h. As per claim 9, Special Edition Using Microsoft Outlook 2000 teaches wherein the email data in said new document is sorted by date of receipt of the email message from which the data was retrieved (See page 14).

i. As per claim 10, Special Edition Using Microsoft Outlook 2000 teaches wherein the email data in said new document is sorted by sender (See page 10).

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of U.S. Patent No. 6,643,694 to Chernin as applied to claim 1 above, and further in view of U.S. Patent Application No 2003/0163468 to Freeman et al.

a. As per claim 2, Special Edition Using Microsoft Outlook 2000 in view of Chernin teaches the claimed invention as described above. However, Special Edition Using Microsoft Outlook 2000 in view of Chernin fails to teach forwarding said new document to a user of said electronic device.

Freeman et al teaches a document stream operating system. Furthermore, Freeman et al teaches forwarding new document to a user of said electronic device (See page 4, paragraph [0051]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate forwarding said new document to a user of said electronic device as taught by Freeman et al in the claimed invention of Special Edition Using Microsoft Outlook 2000 in view of Chernin in order to organize data unit (See page 2, paragraph [0019]).

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of U.S. Patent No. 6,643,694 to Chernin as applied to claim 3 above, and further in view of U.S. Patent Application No U.S. Patent No. 5,634,124 to Khoyi et al.

a. As per claim 11, Special Edition Using Microsoft Outlook 2000 in view of Chernin teaches the claimed invention as described above. However, Special Edition Using Microsoft Outlook 2000 in view of Plow et al and further in view of Chernin fails to teach wherein said new document is forwarded to a user after deleting the email data that is duplicative.

Khoyi et al teaches data integration by object management. Furthermore, Khoyi et al teaches wherein said new document is forwarded to a user after deleting the email data that is duplicative (See col. 40, lines 8-30).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein said new document is forwarded to a user after deleting the email data that is duplicative as taught by Khoyi et al in view of Special Edition Using Microsoft Outlook 2000 in view of Chernin in order to a highly integrated, yet extensible system (See col. 2, lines 44-45)

5. Claim 12-13, 15 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of U.S. Patent No. 6,718,518 to Plow et al and further in view of U.S. Patent No. 6,216,122 to Elson.

a. As per claims 12 and 18, Special Edition Using Microsoft Outlook 2000 teaches providing a storage locations for storing email messages, said email messages including a header and a body, said storage locations accessible by said email application (See page 3 and figure 18.7); providing a search feature for use with said email application, said search feature including a user-input parameter, said search feature using said parameter to reference data in said email messages (See page 1); However, Special Edition Using Microsoft Outlook 2000 fails to teach searching said storage locations with said search feature, said search feature copying less than all the data in a selected email message containing data referenced by said parameter; inserting the copied data from said selected email message and a hyperlink to said selected email message into a new document and plurality of storage location.

Plow et al teaches a non-disruptive search facility. Furthermore, Plow et al teaches searching said storage locations with said search feature, said search feature copying less than all the data in a selected email message containing data referenced by said parameter; inserting the copied data from said selected email message and a hyperlink to said selected email message into a new document (See col. 6, lines 50-67)

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate searching said storage locations with said search feature, said search feature copying less than all the data in a selected email message containing data referenced by

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said parameter; inserting the copied data from said selected email message and a hyperlink to said selected email message into a new document as taught by Plow et al in the claimed invention of Special Edition Using Microsoft Outlook 2000 in order to display the results of a search operation initiated by a user (See col. 2, lines 42-50)

Elson et al teaches an electronic mail indexing folder having a search scope and interval. Furthermore, Elson et al teaches a plurality of storage locations (See 3, lines 27-44).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate a plurality of storage locations in the claimed invention of Special Edition Using Microsoft Outlook 2000 in view of Plow et al in order to provide continual access to the search result without having to specify the search each time the user wants to see the result (See col. 1, lines 55-58).

b. As per claims 13 and 19, Special Edition Using Microsoft Outlook 2000 teaches searching the header of said email messages for data referenced by said parameter; searching the body of said email messages for data referenced by said parameter; and searching any email attachments for data referenced by said parameter (See page 4).

c. As per claim 15, Special Edition Using Microsoft Outlook 2000 teaches wherein said search feature is integrated with said email application (See page 1).

6. Claims 14, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of U.S. Patent No. 6,718,518 to Plow et al and further in view of U.S. Patent No. 6,216,122 to Elson as applied to claims 12 and 18 above, and further in view of U.S. Patent No. 6,643,694 to Chernin.

a. As per claims 14 and 20, Special Edition Using Microsoft Outlook 2000 teaches the claimed invention as described above. However, Special Edition Using Microsoft Outlook 2000 fails to teach wherein said new document is in Hypertext Markup Language (HTML) format.

Chernin teaches wherein the document is in Hypertext Markup Language (HTML) (See col. 34).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the document is in Hypertext Markup Language (HTML) as taught by Chernin in the claimed invention of Special Edition Using Microsoft Outlook 2000 in order to display the results of the e-mail search (See col. 34, lines 64-67),

b. As per claim 16, Special Edition Using Microsoft Outlook 2000 teaches wherein said search feature is a stand-alone application (See page 2).

7. Claims 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of U.S. Patent No.

6,718,518 to Plow et al and further in view of U.S. Patent No. 6,216,122 to Elson as applied to claims 12 and 18 above, and further in view of U.S. Patent No. 5,634,124 to Khoyi et al.

a. As per claim 17 and 21, Special Edition Using Micorosoft Outlook 2000 in view of Plow et al and further in view of Elson et al teaches the claimed invention as described above. However, Special Edition Using Micorosoft Outlook 2000 in view of Plow et al and further in view of Elson et al fail to teach wherein said new document is forwarded to a user after deleting the email data that is duplicative.

Khoyi et al teaches data integration by object management. Furthermore, Khoyi et al teaches wherein said new document is forwarded to a user after deleting the email data that is duplicative (See col. 40, lines 8-30).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein said new document is forwarded to a user after deleting the email data that is duplicative as taught by Special Edition Using Micorosoft Outlook 2000 in view of Plow et al and further in view of Elson et al in order to a highly integrated, yet extensible system (See col. 2, lines 44-45).

8. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Micorosoft Outlook 2000 by Gordon Padwick in view of U.S. Patent No. 6,216,122 to Elson and further in view of U.S. Patent No. 5,915,249 to Spencer.

a. As per claim 22, Special Edition Using Microsoft Outlook 2000 teaches providing a plurality of storage locations for storing email messages, said email messages including a header and a body, said storage locations accessible by said email application (See page 3 and figure 18.7); providing a search feature for use with said email application, said search feature including a user-input parameter, said search feature using said parameter to reference data in said email messages (See page 4); searching said storage locations with said search feature, said search feature copying less than all the data in a selected email message containing data referenced by said parameter inserting the copied data from said selected email message into a new document (See page 1); However, Special Edition Using Microsoft Outlook 2000 fails to teach a plurality of storage locations and caching a copy of said new document and cross-referencing said new document copy and said search request in an index of cached documents.

Elson et al teaches an electronic mail indexing folder having a search scope and interval. Furthermore, Elson et al teaches a plurality of storage locations (See 3, lines 27-44).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate a plurality of storage locations in the claimed invention of Special Edition Using Microsoft Outlook 2000 in view of Plow et al in order to provide continual access to the search result without having to specify the search each time the user wants to see the result (See col. 1, lines 55-58).

Spencer teaches system and methods for accelerated query evaluation of very large full-text databases. Furthermore, Spencer teaches caching a copy of said new document and cross-referencing said new document copy and said search request in an index of cached documents (See col. 5, lines 36-47).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate caching a copy of said new document and cross-referencing said new document copy and said search request in an index of cached documents as taught by Spencer in the claimed invention of Special Edition Using Microsoft Outlook 2000 in view of Elson in order to improve performance (See col. 5, lines 36-47)

8. As per claim 23, Special Edition Using Microsoft Outlook 2000 in view of Elson et al teaches the claimed invention as described above. However, Special Edition Using Outlook 2000 in view of Elson et al fails to teach searching said index for cached documents cross-referenced to a search request; retrieving a cached document responsive to said search request; searching said storage locations for additional responsive data in email messages stored after a last modification date of said responsive cached document; updating said cached document with said responsive data so that only non-duplicative data is inserted into said cached document; and changing said modification date of said cached document to reflect the date of said search request.

Spencer teaches searching said index for cached documents cross-referenced to a search request; retrieving a cached document responsive to said search request; searching said storage locations for additional responsive data in email messages stored after a last modification date of said responsive cached document; updating said cached document with said responsive data so that only non-duplicative data is inserted into said cached document; and changing said modification date of said cached document to reflect the date of said search request (See col. 5, lines 36-47).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate searching said index for cached documents cross-referenced to a search request; retrieving a cached document responsive to said search request; searching said storage locations for additional responsive data in email messages stored after a last modification date of said responsive cached document; updating said cached document with said responsive data so that only non-duplicative data is inserted into said cached document; and changing said modification date of said cached document to reflect the date of said search request as taught by Spencer in the claimed invention of Special Edition Using Microsoft Outlook 2000 in view of Elson et al in order to improve performance (See col. 5, lines 36-47)

c. As per claim 24, Special Edition Using Microsoft Outlook 2000 in view of Elson et al teaches wherein said cached document is forwarded to a user.

Spencer teaches wherein said cached document is forwarded to a user (See col. 5, lines 36-47).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein said cached document is forwarded to a user as taught by Spencer in the claimed invention of Special Edition using Microsoft Outlook 2000 in view of Elson et al in order to improve performance (See col. 5, lines 36-47).

Conclusion

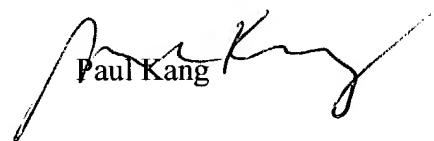
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M Bayard whose telephone number is (703) 305-6606. The examiner can normally be reached on 7:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Djenane Bayard

Patent Examiner



Paul Kang

Primary Patent Examiner